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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,235	09/19/2003	Taroh Terashi	2271/71043	8483

7590

11/14/2005

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EXAMINER
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BROWN, JAYME L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/666,235

Applicant(s)

TERASHI ET AL.

Examiner

Jayme L. Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-9, drawn to a method for adhering parts with light energy curing adhesive, classified in class 156, subclass 275.5.
  - II. Claims 10-18, drawn to a parts adhering apparatus, classified in class 156, subclass 379.6.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as coating only one section between the part and the adhering target with the light energy curing adhesives.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed invention:

**If Applicant elects Group I, the species restriction is as follows:**

**Species A** – A method wherein the curing shrinkage forces are adjusted to be even by selectively irradiating the light energy to at least one of the light energy curable adhesives (appears to read on claim 4).

**Species B** – A method wherein the curing shrinkage forces are adjusted to be even by changing intensity of the light energy irradiated to each of the light energy curable adhesives (appears to read on claim 5).

**Species C** – A method wherein the curing shrinkage forces are adjusted to be even by changing an irradiation area of the light energy irradiated to at least one of the light energy curable adhesives (appears to read on claim 6).

**Species D** – A method wherein the curing shrinkage forces are adjusted to be even by coating at least one of the plural sections with plural light energy curable type adhesives having different shrinkage characteristics to be selectively irradiated when selected displacement from the relative position occurs (appears to read on claim 7).

**Species E** – A method wherein the curing shrinkage forces are adjusted to be even by coating at least one of the plural sections with a different amount of light energy curable type adhesive (appears to read on claim 8).

**Species F** – A method wherein the curing shrinkage forces are adjusted to be even by coating at least one of the plural sections with light energy curable type adhesive in a different shape (appears to read on claim 9).

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**If Applicant elects Group II, the species restriction is as follows:**

**Species A** – An apparatus comprising an activation control device to change one of an amount and a direction of at least one of the stresses (appears to read on claim 13).

**Species B** – An apparatus comprising an irradiation intensity control device to change one of an amount and a direction of at least one of the stresses (appears to read on claim 14).

**Species C** – An apparatus comprising an irradiation area control device to change one of an amount and a direction of at least one of the stresses (appears to read on claim 15).

**Species D** – An apparatus wherein plural light energy curable type of adhesive having different shrinkage characteristics are provided to at least one of the curing sections in order to change one of an amount and a direction of at least one of the stresses (appears to read on claim 16).

**Species E** – An apparatus wherein a different amount of the light energy curable type adhesive is provided to at least one of the curing sections in order to change one of an amount and a direction of at least one of the stresses (appears to read on claim 17).

**Species F** – An apparatus wherein light energy curable adhesive is coated in a different shape at least at one of the plural sections in order to change one of an amount and a direction of at least one of the stresses (appears to read on claim 18).

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

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finally held to be allowable. Currently, claims 1-3 are generic in Group I, and claims 10-12 are generic in Group II.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Mr. Paul Teng on November 7, 2005 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jayme L. Brown whose telephone number is 571-272-8386. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dunn can be reached on 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Jayme L. Brown*

Jayme L. Brown

  
GLADYS J.P. CORCORAN  
PRIMARY EXAMINER